

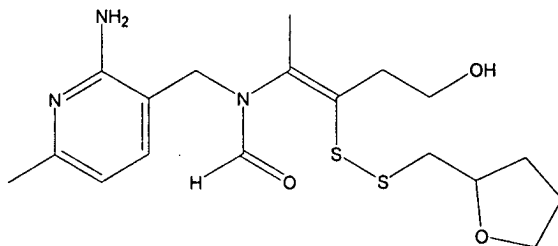
REMARKS

Claims 1, 2 and 4-22 are pending in the application. Claims 12-22 are hereby cancelled. Applicants expressly reserve the right to re-file cancelled claims 12-22 in one or more divisional applications.

New claims 23-25 are hereby added. Adequate support for new claims 23-25 and for each of the claim amendments made herein is found in the specification of the instant application as originally filed.

In response to the restriction requirement imposed in the Office Action dated November 13, 2009, Applicants elect with traverse to prosecute the invention of Group I, claims 1, 2, and 4-11, drawn to a compound of formula I and simple compositions thereof wherein ring A is 3-pyridinyl. Claims 1, 2, 4-11, and new claims 23-25, as pending or as amended herein, conform to this election.

Applicants further elect with traverse to prosecute a species of group I, wherein the species has the chemical structure:



Claims 1, 2, 4-11, new claim 23 species (b), and new claims 24 and 25, as pending or as amended herein, read on the above elected species.

In addition to examining the elected chemical species of new claim 23 (species (b)) and new claim 24, Applicants respectfully request that the Examiner examine all of the species of new claim 23 (including species (a) and (c)-(p)) and the sub-genus of new claim 25, which encompasses the elected species and each of the species of new claim 23.

Species (a) and (c)-(p) of new claim 23 either replicate or repeat the same pharmacore as elected species (b) of claim 23. The relatively limited number of species

of new claim 23 reflects the minor substituent variations between each of the species of new claim 23. Therefore, as explained below, the elected species and the other species covered by new claims 23-25 are each part of the same invention.

It is well settled that claims to compounds that have an identical nucleus (pharmacore), a variety of substituents, and a common utility, are part of a single invention. The alleged burden of searching such an invention in different fields of search and different search classifications plays absolutely no role in the determination of unity *vel non*. See *In re Harnisch*, 206 U.S.P.Q. 300 (CCPA 1980). The claimed compounds must be considered as a whole, and not separately based on the different substituents on the common central nucleus (pharmacore).

There is a unity of invention where, as in the case of the species of new claims 23-25, the central nucleus (pharmacore) is identical in each occurrence, especially if – as here – all of the compounds have a common utility and function, belong to a common, recognized genus, and share a community of properties. See *ex parte Brouard*, 201 U.S.P.Q. 538 (Bd. App., 1976). The determination of unity of invention does not *require* that there be a community of properties (although in the present application, this happens to be the case), as long as the covered compounds have a common nucleus which would exhibit certain characteristics. See *ex parte Taylor*, 167 U.S.P.Q. 637 (Bd. App., 1969).

It is unequivocal that as long as all of the compounds have a common nucleus, they represent a single invention regardless of the number and type of substituents on that common nucleus and the alleged burden of searching the invention in different fields of search. Further, it is also clear that different search classifications play no role in the determination of unity of invention. It is respectfully submitted that a restriction requirement with respect to species (a) and (c)-(p) of new claim 23 and/or the proposed sub-genus of new claim 25 would be improper and Applicants respectfully request the Examiner to issue a first office action or a notice of allowance on the merits without further restriction.

Notwithstanding the presentation of the elected invention and species and proposed additional species and sub-genus, Applicants respectfully request that the Examiner withdraw his restriction requirement in its entirety since examination of all of

the originally filed claims may be made in conformity with applicable law and regulations. For the reasons provided below, it is respectfully submitted that examination of all of the originally filed claims would not be overly burdensome and withdrawal of the restriction requirement is appropriate.

According to MPEP § 803, restriction of patentably distinct inventions is proper if the claimed inventions are independent and a serious burden would be placed on the Examiner if restriction was not required. Applicants respectfully submit that the presentation of all of the originally filed claims did not place such a serious burden on the Examiner as to require restriction. All of the originally filed claims are related though similar compositions and methods, have a common utility, and are readily searched without undue effort.

Although the claimed invention groups are generally patentably distinct from each other, Applicants maintain that any search the Examiner would need to conduct in examining the instant application and the examination itself would not be unduly burdensome. Moreover, the examination of all of the originally filed claims in the instant application would not place such a serious burden on the Examiner as to require restriction. When the general policy considerations for the Patent Office's requirement for restriction in certain instances are balanced against the administrative efficiency of examining all of the readily searchable invention groups (I)-(IX), it becomes clear that withdrawal of the outstanding restriction requirement is proper.

Applicants respectfully submit that the originally filed claims are sufficiently narrow to allow the Examiner to determine patentability without being subjected to the serious burden referred to in MPEP § 803. Consequently, Applicants respectfully request that the Examiner withdraw the restriction requirement in its entirety.

The Examiner is cordially requested to call the undersigned attorney if the Examiner believes that a telephonic discussion may materially advance the prosecution of the instant application in any way.

A petition for a one-month extension of time to respond to the November 13, 2009 Office Action and an authorization to charge Deposit Account 04-0838 for all fees due in connection with this response are filed simultaneously herewith. If any additional

fee is due or any overpayment has been made, please debit or credit Deposit Account 04-0838.

Respectfully submitted,

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By: 

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Reg. No. 32,559

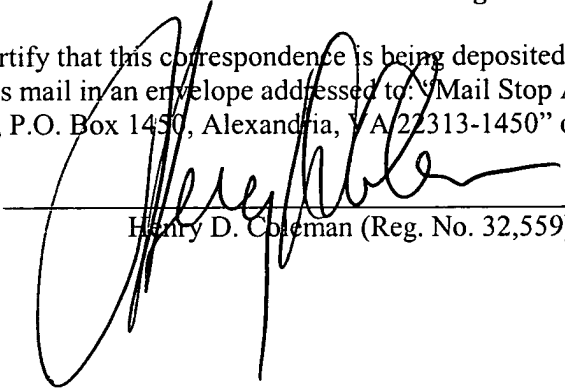
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Certificate of Mailing

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as first class mail in an envelope addressed to: "Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" on December 31, 2009.


Henry D. Coleman (Reg. No. 32,559)